

DETAILED ACTION

Please note that the Examiner for this application has changed. Please note that the addition of NEW Claims has necessitated an additional requirement for an election of species. Claims 1-115, 117-176 and 183-242 are cancelled. Claims 181-182 and 243 are withdrawn. Claims 116, 177-182 and 243-303 are pending. Claims 242-303 are NEW. Claims 116, 177-180 and 244-303 are subject to the present Election/Restriction Requirement.

Election/Restrictions

Applicant's election without traverse of Group III (claims 116 and 177-180) and of the species "(i) one or more inducers", in the reply filed on 5 September 2008 is acknowledged.

Applicants statement in the Response to Election/Restriction filed 5 September 2008 that the newly added Claim 243 belongs in the Restriction Group IV is acknowledged and Claim 243 will be place in the Restriction Group IV herein.

Claims 181-182 and 243 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected subject matter, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 5 September 2008.

Applicants addition of new Claims 244-303, which belong to the elected invention Group III, in the Amendments to the Claims filed 5 September 2008 have been

considered and have necessitated an additional Election of Species Requirement (see below).

Additional Election of Species is required under 35 U.S.C. 121 and 372.

For reasons already of record in the Office Action mailed 5 September 2008, this application contains inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1. Therefore, restriction under 35 U.S.C. 121 and 372 is proper.

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

-Applicant must elect only one type of first and second molecule from among the mutually exclusive species of Claims 250-252 (e.g. Applicant must choose either Claim 250, 251 or 252).

-Applicant must elect only one type of first and second molecule that corresponds to the election of Claims 250-252 (above) such that the sequence of the first and second molecule is defined (e.g. crR10, taR12) and such that the requirements for features of the nucleic acids are not mutually exclusive (e.g. limitations for stem lengths are not mutually exclusive and limitations for loop lengths are not mutually exclusive).

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The following claim(s) are generic: Claim 116 is generic to the species of Group III.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: Each species requires a unique sequence that defines a special technical feature that is not shared by the other identified species.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does

not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Possible Rejoinder

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP

§ 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CATHERINE S. HIBBERT whose telephone number is (571)270-3053. The examiner can normally be reached on M-F 8AM-5PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on 571-272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Catherine S. Hibbert
Examiner/AU1636

/David Guzo/
Primary Examiner
Art Unit 1636